

REMARKS

Reconsideration of the present application is respectfully requested. Claims 38 to 42, 44 to 49 and 51 to 57 are currently pending, and no claims have been amended.

The Office Action mailed June 11, 2003 addressed claims 38 to 42, 44 to 49 and 51 to 57. Claims 38 to 42, 44 to 49 and 51 to 57 were rejected.

Claims 38 to 42, 44 to 49 and 51 to 57 were rejected under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. (5,779,563) in view of Sullivan et al. (5,368,304). Regarding claim 38, the Examiner stated that Yamagishi discloses a golf ball comprising a solid core, an inner cover layer and an outer cover layer, the inner cover layer is made from Himilan (an ionomer), and the outer cover is made from polyurethane and has a Shore D hardness from 40 to 68. The Examiner stated that Yamagishi does not disclose the PGA compression of the core, but Sullivan teaches a core with a PGA compression between 45 and 85. Regarding claim 40, the Examiner stated that the ball has a diameter of 42.7 mm or 1.68 inches; regarding claim 42, the outer cover layer has a Shore D hardness of 40 to 68; regarding claims 44 and 45, the outer cover layer has a thickness of 0.3 to 2.5 mm or 0.01 to 0.098 inches; and regarding claim 47, the solid core is made from a polybutadiene, the outer cover layer is made from polyurethane and has a Shore D hardness of 40 to 68. Regarding claims 51 and 52, the Examiner stated that the outer cover layer has a thickness of 0.3 to 2.5 mm or 0.01 to 0.098 inches; and regarding claim 53, the solid core is made from a polybutadiene, the inner cover layer is made from Himilan, and the outer cover is made from polyurethane and has a Shore D hardness from 40 to 68. Regarding claim 55, the Examiner stated that the ball has a diameter of 42.7 mm or 1.68 inches. Regarding claims 39, 41, 48, 54 and 56, the Examiner stated that Applicant claims a PGA compression and coefficient of restitution, and the properties are obvious over Yamagishi because Yamagishi discloses a solid golf ball comprising a polybutadiene core, an ionomeric cover and a polyurethane outer cover, and Applicant claims the same materials disclosed by Yamagishi for each layer. The Examiner further stated that although Yamagishi is silent, one skilled in the golf ball art is aware that golf balls commonly have a PGA compression between 70 and 100, and the COR has a common range in the golfing art between 0.7 and 0.8. Regarding claims 46, 49 and 57, the Examiner stated that Yamagishi in view of Sullivan discloses Applicant's invention therefore the performance features such as mechanical impedance will also be the same as Applicant's. The Examiner concluded that

one of ordinary skill in the art would have modified Yamagishi in view of Sullivan to achieve the optimal initial velocity and spin of the golf ball.

Applicants respectfully disagree with the Examiner. Claims 38, 47 and 53 claim a golf ball with a core having a PGA compression of 55 or less and the golf ball has a PGA compression of 80 or less. Applicants respectfully submit that Yamagishi et al. does not disclose a golf ball with a core having a PGA compression of 55 or less or where the golf ball has a PGA compression of 80 or less, nor does Yamagishi et al. provide any suggestion or teaching to make a golf ball with the PGA compression of Applicants' golf balls. Yamagishi discloses a golf ball wherein the outer cover layer has a higher specific gravity than the core and inner cover layer, and the ball has an inertia moment within a certain range.

Sullivan discloses a low spin golf ball comprising a core and a single cover layer, and the golf ball is preferably a large diameter ball (greater than 1.68 inches). Sullivan discloses a core having a Riehle compression of at least 75 (a PGA compression of 85 or less), and all of the examples of Sullivan have a core PGA compression of at least 73, and a ball PGA compression of at least 95. Sullivan does not disclose a ball wherein the PGA compression of the ball is limited to 80 or less, and the examples of Sullivan clearly teach away from a ball having a core PGA compression of 55 or less.

Applicants respectfully submit that even if Sullivan taught the PGA compression of the core and/or the ball required by Applicants' claims, which Applicants submit it does not, the Examiner has shown no motivation, suggestion or teaching to combine Sullivan with Yamagishi. Applicants respectfully submit that one skilled in the art would not combine the two references because Yamagishi is directed to a golf ball with multi-layer cover, and all of the examples of Yamagishi have a relatively soft cover (Shore D of 55 or less for the examples of the invention), and Sullivan is directed to a golf ball with a large diameter core and a single layer cover wherein the golf ball has low spin, and the cover is hard (at least 65 Shore D). Even if Sullivan was combined with Yamagishi, Applicants respectfully submit that the golf ball of Applicants' claims would not be produced because neither Yamagishi nor Sullivan, alone or in combination, discloses Applicants' golf ball.

Applicants respectfully submit that the burden is on the Examiner to provide a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent or

obvious characteristics necessarily flow from the teachings of the prior art. Inherency must be a necessary result and not merely a possible result. Applicants respectfully submit that the Examiner has failed to support the inherency determination with any facts or technical reasoning. Even if it is true that golf balls commonly have a PGA compression between 70 and 100, as stated by the Examiner, this is different from a golf ball having a PGA compression of 80 or less.

For at least these reasons, Applicants respectfully submit that claims 38 to 42, 44 to 49 and 51 to 57 are not obvious under 35 U.S.C. § 103(a) over Yamagishi et al. in view of Sullivan et al. Applicants therefore respectfully request that the rejection of claims 38 to 42, 44 to 49 and 51 to 57 be reconsidered and withdrawn.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

#### CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 38 to 42, 44 to 49 and 51 to 57. Applicants respectfully request allowance of claims 38 to 42, 44 to 49 and 51 to 57, the claims currently pending.

Respectfully submitted,

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